

REMARKS

Claims 1-52 are pending in the application. In the Office Action dated November 18, 2002, the Examiner withdrew from consideration claims 2, 10, 14, 15, 21, 32, 36, 37, and 46-48 as being drawn to a non-elected species. The Examiner rejected claims 26-31, 33-35 and 38-48 under 35 U.S.C. § 112, second paragraph, because intervening base claim 26 recited the limitation "the gasket or seal" without proper antecedent basis. The Examiner further rejected claims 1, 3-9, 11-13, 16-20, 22-31, 33-35, 38-45 and 49-52 under 35 U.S.C. § 102(e) as being anticipated by published U.S. Patent Application No. 2001/0010852A1 to Cotton *et al.* Reconsideration of the invention is requested in light of the present amendment and following remarks.

Applicant acknowledges the species election, that claims 1, 3-9, 11-13, 16-20, 22-31, 33-35, 38-45 and 49-52 are currently pending, and that examination of the withdrawn dependent species claims will be considered upon allowance of a generic or linking claim.

With respect to the rejection under § 112, second paragraph, claim 26 has been amended to draw dependency from claim 25 as originally intended rather than claim 24, which was a typographical error. Accordingly, withdrawal of the rejection of claims 26-31, 33-35 and 38-48 on this ground is respectfully requested.

In addition, claim 25 has been amended to properly recite "at least one of a gasket and seal" as is most proper for a claim that recites elements that are inclusively "and/or" (either one or both) rather than exclusively "or" (in the alternative). The Examiner will appreciate that this is a formality of claim language and the same captures the intent of the claim.

The rejections over Cotton *et al.* are obviated by the declaration under 37 C.F.R. § 1.131 and accompanying Exhibits enclosed herewith. Cotton *et al.* was filed July 22, 1998, as a non-provisional of a provisional application filed July 30, 1997. Cotton *et al.* was not published until August 2, 2001, which is subsequent to the filing date of the instant application. Therefore, Cotton *et al.* may only be considered prior art under § 103/102(e). Without reaching the question of whether a claim to priority to the provisional application is

properly made in Cotton *et al.*, or whether the earlier provisional application itself discloses the subject matter of the published application, the Declaration pursuant to 37 C.F.R. § 1.131 submitted herewith by Maurice Harding Jr., the inventor of the present application, establishes that he conceived the invention and was diligent in actual reduction practice thereof, prior to July 30, 1997, the earliest potential priority date of Cotton *et al.* Therefore, Cotton *et al.* is not valid prior art to the present application.

More particularly, the Declaration and Exhibits provide evidence that the inventor conceived the invention prior to July 30, 1997, reduced the invention to practice by testing various experimental designs on his own vehicle to obtain results showing various embodiments thereof to be operable. Accordingly, Maurice Harding Jr., invented the claimed device before the priority date of Cotton *et al.*, making the rejection under section 103 moot because Cotton *et al.* is not valid prior art under § 102(e).

The Declaration submitted herewith is provided solely to facilitate prosecution of the application. Applicant does not admit that the cited art would otherwise anticipate or render obvious any of the embodiments claimed in the present application.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with Markings to Show Changes Made**".

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

DORSEY & WHITNEY LLP



Mark W. Roberts, Ph.D.
Registration No. 46,160

MWR:sj

Enclosures:

Postcard
Fee Transmittal Sheet (+ copy)
Declaration Under 37 C.F.R. § 1.131
Exhibits A, B, C, and D
Information Disclosure Statement

1420 Fifth Avenue, Suite 3400
Seattle, WA 98101-4010
(206) 903-8728 (telephone)
(206) 903-8820 (fax)

\\sefile05\files2\ip\documents\clients\maurice b. harding, jr\501005.01 amendment 111802.doc

VERSION WITH MARKINGS TO SHOW CHANGES MADE

25. (Amended) The device of claim 24 wherein the machined assembly is selected from the group consisting of an engine and an automotive vehicle, and where the joint includes at least one of a gasket [or] and seal between parts of the machined assembly.

26. (Amended) The device of claim [24] 25 wherein the gasket or seal is for a part selected from the group consisting of an oil pan, a valve cover, a transmission pan, a differential housing, a rocker-arm cover, and a bearing seal.

\\Sefile05\Files2\IP\Documents\Clients\Maurice B. Harding, Jr\501005.01 amendment 111802.doc